



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/025,345 02/18/98 HINSHAW

J PMS-244198

PM51/0112  
CUSHMAN DARBY & CUSHMAN  
1100 NEW YORK AVENUE, N. W.  
NINTH FLOOR  
WASHINGTON, DC 20005-3918

EXAMINER

MILLER, E

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 01/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

HENRY P. SARTORIO  
DEPUTY LABORATORY COUNSEL FOR PATENTS  
LAWRENCE LIVERMORE NATIONAL LABORATORY  
KENDREW H. COLTON  
CUSHMAN, DARBY AND CUSHMAN  
1100 NEW YORK AVE., N.W.  
NINTH FLOOR  
WASHINGTON, DC 20005-3918

IN RE: HINSHAW et al. : RESPONSE TO LETTER  
SERIAL NUMBER: 09/025,345  
FILED: February 18, 1998  
DOCKET # PMS-244198

FOR: METAL COMPLEXES FOR USE AS GAS GENERANTS

This is in response to your letter of December 13, 2000 asking for review of the examiner's action.

Applicants' specific concerns are related to their comments at pages 2 and 3 of the instant letter. These remarks appear to concern the examiner's restriction practice and the propriety of the Final rejection, mailed on 9/13/2000. Other issues raised in your remarks are directed to art applied to the claims. These issues cannot be addressed here in that they are appealable rather than petitionable.

With respect to the requirement for restriction requirement, applicants' state that the application can be made without serious burden even though it includes claims to independent and distinct inventions.

MPEP 803 states:

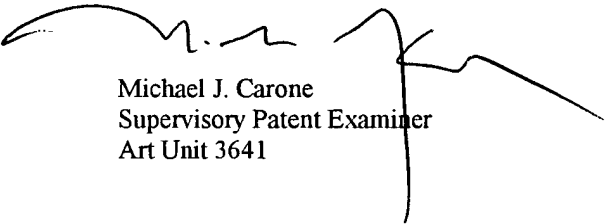
"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02."

Referring to the examiner's restriction requirement mailed on March 24, 1999, the examiner provided the following "burden" statement: "Because these inventions are distinct for reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination requirement is proper." Thus, in that the examiner has provided a prima facie showing for serious burden as separate classification, the examiner's actions are considered commensurate with Office policy and proper. Additionally, in applicants' response to the restriction requirement filed on May 29, 1999, provided no rebuttal to the requirement.

With respect to the Finality of the rejection mailed 9/13/2000, applicants contend that the examiner failed to examine claim 102. The contention is based on the understanding by applicants that the claim reads on the elected species. However, the reasons set forth in the advisory action mailed on 12/21/2000 gives reasons why claim 102 does not read on the elected species. In the absence of any persuasive evidence or reasoning of why the claims read on the elected species, in light of the

examiners comments in the advisory action, the final rejection appears proper with respect to this one issue.

If applicants have any further questions or concerns related to this letter, feel free to call me at (703) 306-4198 in an effort to expedite these issues.



Michael J. Carone  
Supervisory Patent Examiner  
Art Unit 3641